

Docket No.: 223002099600
223002099601
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Provisional and Patent Application of:
Vincenzo SCARLATO et al.

Patent No.: 6,914,131

Art Unit: 1631

Issued: July 5, 2005

Examiner: Shubo ZHOU

Patent Ser. No.: 10/864,684 (continuation of above)

Art Unit: 1645

Filed : June 8, 2004

Examiner: P. Baskar

For: NEISSERIAL ANTIGENS

**PETITION FOR RETROACTIVE FOREIGN FILING LICENSE
PURSUANT TO 37 CFR § 5.25**

MS L&R
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

It is respectfully requested that this petition for retroactive foreign filing license be granted under the provisions of 35 U.S.C. § 184 and 37 CFR § 5.25 for the following foreign patent applications:

- GB App. No. 9723516.2, filed Nov. 6, 1997;
- GB App. No. 9724190.5, filed Nov. 14, 1997;
- GB App. No. 9724386.9, filed Nov. 18, 1997;
- GB App. No. 9725158.1, filed Nov. 27, 1997;
- GB App. No. 9726147.3, filed Dec. 10, 1997;
- GB App. No. 9800759.4, filed Jan. 14, 1998;

- GB App. No. 9819016.8, filed Sept. 1, 1998; and
- PCT App. No. PCT/IB98/001665, filed Oct. 9, 1998 (collectively, the “**GB Priority and PCT Applications**”).

In addition, to the extent that the foreign filing license granted for the subject matter of U.S. Ser. No. 09/303,518 granted June 9, 1999 is ineffective for the following later filed foreign patent applications and patents, it is respectfully further requested that this petition for retroactive foreign filing license be granted under the provisions of 35 U.S.C. § 184 and 37 CFR § 5.25 for the following additional foreign patent applications and patents:

- BR App. No. PI9813930-4, filed May 4, 2000;
- CA App. No. 2308606, filed May 4, 2000;
- CN Pat. No. CN1263854, filed June 30, 2000;
- EP App. No. 98946675.0 (issued as EP1029052), filed April 28, 2000 (together with national patents issuing therefrom);
- HK App. No. 00105869.7, filed Sept. 19, 2000;
- JP App. No. 2000-520572, filed May 2, 2000;
- MX App. No. PA/a/00/004363, filed May 4, 2000;
- RU App. No. 2000114245 (issued as RU Pat. No. RU223291), filed June 5, 2000; and
- SG App. No. SG72388, filed April 18, 2000 (collectively, the “**National Phase Foreign Patent Applications**”).
- BR Div. No. PI9816251-9, filed July 31, 2007;
- CN Div. No. 200510113395.7, filed Oct. 17, 2005;
- EP Div. No. 07075379.3 (published as EP1900818), filed May 21, 2007;
- CA Div. No. 2,671,261, filed May 14, 2009;
- HK App. No. 01103903.9 (issued as HK Pat. No. 1033337), filed June 6, 2001;
- JP Div. No. 2005-290551, filed Oct. 3, 2005;
- MX Div. No. MX/a/2009/000817, filed Jan. 21, 2009; and

- RU Div. No. 2004100847, filed Jan. 8, 2004 (collectively, the “**Foreign Divisional Patent Applications**”)

In support of this petition, attached hereto are copies of:

1. The Corrected Filing Receipt for U.S. Ser. No. 09/303,518 indicating that the foreign filing license was granted on June 9, 1999 for the subject matter of the U.S. patent application which includes all of the subject matter disclosed in the GB Priority and PCT Applications, the National Phase Foreign Patent Applications and the Foreign Divisional Patent Applications;
2. Statement in support of 37 C.F.R. § 5.25 Petition by Otis Littlefield;
3. Statement in support of 37 C.F.R. § 5.25 Petition by Cameron Marshall;
4. Statement in support of 37 C.F.R. § 5.25 Petition by Huw Hallybone;
5. Statement in support of 37 C.F.R. § 5.25 Petition by Melodi Dice;
6. Statement in support of 37 C.F.R. § 5.25 Petition by Alisa Harbin; and
7. Statement in support of 37 C.F.R. § 5.25 Petition by Amy Hessler.

The statement attached hereto of Otis Littlefield is made in accordance with 37 CFR § 5.25 (a)(3)(i)-(iii), establishing: (a) that the subject matter was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order; and (b) the license is being diligently sought after discovery of the proscribed foreign filing. The statement attached hereto of Cameron Marshal and Huw Hallybone are made in accordance with 37 CFR § 5.25 (a)(3)(i)-(iii), establishing: (a) the license is being diligently sought after discovery of the proscribed foreign filing; and providing (b) an explanation of why the seven GB patent applications, the two EP patent applications, and the PCT application were filed abroad through error and without deceptive intent without the required license under 37 CFR § 5.11 first having been obtained. The statement attached hereto of Alisa Harbin is made in accordance with 37 CFR § 5.25 (a)(3)(i)-(iii), providing an explanation of why the PCT patent application and, if a retroactive foreign filing license is required, the PCT national stage patent applications were filed abroad through error and without deceptive intent without the required license under 37 CFR § 5.11 first having been obtained. The

statement attached hereto of Melodi Dice is made in accordance with 37 CFR § 5.25 (a)(3)(i)-(iii), providing an explanation of why the PCT national stage patent applications were filed abroad through error and without deceptive intent without the required license under 37 CFR § 5.11 first having been obtained if the foreign filing license previously granted for U.S. Ser. No. 09/303,518 is ineffective. The statement attached hereto of Amy Hessler is made in accordance with 37 CFR § 5.25 (a)(3)(i)-(iii), providing an explanation of why certain foreign divisional patent applications were filed abroad through error and without deceptive intent without the required license under 37 CFR § 5.11 first having been obtained if the foreign filing license previously granted for U.S. Ser. No. 09/303,518 is ineffective.

a. *The foreign filings without a foreign filing license were through error and without deceptive intent*

As indicated in statement attached hereto of Otis Littlefield, the subject matter in the foreign filed patent applications was not under a secrecy order at the time they were filed abroad, and is not currently under a secrecy order as indicated by the foreign filing license issued for U.S. Ser. No. 09/303,518.

b. *The foreign filings without a foreign filing license were through error and without deceptive intent*

As indicated in the attached statements of Cameron Marshall, Huw Hallybone, and Alisa Harbin, when the priority applications were filed, both the outside counsel and the in-house counsels corresponded with the Italian inventors at the Italian facility for Chiron SpA. None of them knew or had reason to believe that any of the work was performed in the United States and therefore no foreign filing license was obtained prior to filing the seven GB patent applications. Therefore, the seven GB patent applications were filed due to error and without deceptive intent without a foreign filing license having been obtained.

As indicated in the attached statements of Cameron Marshal, Huw Hallybone and Alisa Harbin, additional inventors were added to the file for purposes of filing a PCT application claiming

priority to the seven GB patent applications. Alisa Harbin confirmed that the additional inventors were also Italian citizens employed by Chiron SpA in Siena. Again, none of Alisa Harbin, Cameron Marshall and Huw Hallybone knew or had reason to believe that any of the work was performed in the United States and therefore no foreign filing license was obtained prior to filing the PCT application. Therefore, the PCT patent application was filed due to error and without deceptive intent without a foreign filing license having been obtained

As indicated in the attached statements of Alisa Harbin and Melodi Dice, Melodi Dice prepared and sent letters to the foreign associates requesting that they file national stage applications based upon the PCT application based upon a list of countries prepared by Alisa Harbin. Neither Alisa Harbin nor Melodi Dice knew or had reason to believe that any of the work was performed in the United States and therefore no foreign filing license was obtained prior to the PCT national stage applications. In addition, review of the need for foreign filing licenses was not typically performed by Chiron Corporation or its subsidiary Chiron SpA prior to national phase entry where the priority applications were foreign filed. Furthermore, prior to entry into the national phase in any foreign jurisdiction, a continuation-in-part patent application, U.S. Ser. No. 09/303,518, was filed in the United States claiming priority to the PCT application and the seven GB patent applications. As indicated on the Filing Receipt for U.S. Ser. No. 09/303,518 (included herewith), a foreign filing license for the subject matter of U.S. Ser. No. 09/303,518 was granted on June 9, 1999. Since the subject matter of all of the Foreign National Stage Patent Applications and Foreign Divisional Patent Applications was included in the U.S. Ser. No. 09/303,518 granted June 9, 1999, all of the Foreign National Stage Patent Applications and Foreign Divisional Patent Applications were filed after having received a foreign filing license. Therefore, the Foreign National Stage Patent Applications and Foreign Divisional Patent Applications were either filed after having received a foreign filing license or were filed due to error and without deceptive intent without a foreign filing license having been obtained.

As indicated in the statement of Alisa Harbin, in the ordinary course of prosecution of the national phase patent application, Alisa Harbin instructed the foreign associates to file the following divisional application: HK App. No. 01103903.9 (issued as HK Pat. No. 1033337), filed

June 6, 2001; RU Div. No. 2004100847, filed Jan. 8, 2004. Furthermore, even when Alisa Harbin was not directly managing prosecution, the attorney(s) managing the prosecution ultimately reported to her and relied upon her knowledge of the prosecution of this patent family when deciding when and where to file the foreign divisional patent applications including CN Div. No. 200510113395.7, filed Oct. 17, 2005 and JP Div. No. 2005-290551, filed Oct. 3, 2005. Alisa Harbin did not know or have reason to believe that any of the work was performed in the United States and therefore no foreign filing license was obtained prior to the filing of the preceding foreign divisional patent applications. As indicated in the statement of Amy Hessler, in the ordinary course of prosecution of the national phase patent application, Amy Hessler instructed the foreign associates to file the following divisional applications: BR Div. No. PI9816251-9, filed July 31, 2007, EP Div. No. 07075379.3 (published as EP1900818), filed May 21, 2007, CA Div. No. [awaiting confirmation], filed May 14, 2009, and MX Div. No. MX/a/2009/000817, filed Jan. 21, 2009. As Amy Hessler was not involved in the preparation and filing of the GB priority applications or the PCT applications, she was unaware that a foreign filing license had not been obtained, and did not know or have any reason to believe that any of the work was performed in the United States when requesting that the respective foreign divisionals be filed and therefore a foreign filing license may have been needed. Therefore, the Foreign Divisional Patent Applications were either filed after having received a foreign filing license or were filed due to error and without deceptive intent without a foreign filing license having been obtained.

c. Applicants were diligent in filing this petition after discovery of the error.

As indicated in the statement of Otis Littlefield, U.S. outside counsel had become aware that portions of the work of Vega Massignani that is included in the above referenced patent and patent application had been performed in Emeryville, CA around October 2007. At the time of learning this, U.S. outside counsel were unaware that a foreign filing license had not been obtained prior to the filing of the GB Priority and PCT Applications, and therefore were unaware of the significance of Vega Massignani's working in Emeryville. Similarly Amy Hessler did not know that a foreign filing license had not been obtained as she was not involved with the preparation and filing of the GB Priority and PCT Applications. The need for a retroactive foreign filing license first

became apparent on May 6, 2009, when Otis Littlefield and Cameron Marshall were interviewing Vega Masignani regarding work performed by Vega relating to the above patent ant patent application. It was at this interview that Cameron Marshall first heard that work that was included in the above patent and patent application was performed in the US. In addition, having participated in the preparation and filing of the GB priority patent applications, Cameron Marshall was the first individual who was aware of both facts: (a) a foreign filing license had not been obtained prior to filing the GB Priority and PCT Applications, and (b) work that was included in the GB Priority and PCT Applications and in the above patent and patent application was performed in the US. Immediately after the interview, Cameron Marshall alerted Otis Littlefield as to the lack of a foreign filing license having been obtained. Thereafter, as indicated in the statement of Otis Littlefield, the applicants have diligently worked to determine the appropriate course of action, gather the necessary facts, and then prepare and file this petition and the attached statements.

Please charge our Deposit Account No. 03-1952 in the amount of \$200.00 covering the fee set forth in 37 CFR § 1.17(g). The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 03-1952, under Docket No. 223002099600.

Dated: November 10, 2009

Respectfully submitted,

By /Otis Littlefield/
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